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Paper No. 11

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NOV 19 2003

In re Application of:
ALBERT SANTELLI
Serial No. 09/871,315
Filed: May 31, 2001
Attorney Docket No. **Fram Trak-8**

:
: DECISION ON PETITION
: TO WITHDRAW HOLDING
: OF ABANDONMENT

This is a response to the petition under 37 C.F.R. § 1.181, filed October 3, 2003, to withdraw the holding of abandonment of the above-identified application. No fee is required.

The petition is **DENIED**.

This application became abandoned for failure to timely respond to the final Office action mailed on February 27, 2003.

The petitioner asserts that a timely Amendment and Response after Final Rejection and a return post card receipt were mailed to the United States Patent & Trademark Office (USPTO) on May 15, 2003. To support this assertion, petitioner has provided a copy of the post card receipt that acknowledges receipt of an amendment in the USPTO on May 19, 2003.

A review of the application file record reveals that the above-identified response and a facsimile copy are of record in the application file. Further review, shows that the examiner considered the Amendment and Response after Final Rejection and issued an Advisory action denying entry of the Amendment because it raises new issues that would require further consideration and/or search. The Advisory action was dated September 4, 2003 (108 days after filing the Amendment and Response after Final Rejection).

Consideration of proposed after final amendments are addressed in 37 CFR § 1.113, 37 CFR § 1.116, and MPEP 714.13 reproduced, in part, below:

37 CFR § 1.113 (c) states, in part, the following:

“(c) reply to a final rejection or action must include cancellation of or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.”

37 CFR § 1.116 (b) and (c) state, in part, the following:

“(b) ... amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, an amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment...”

“(c) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.”

Section 714.13 of the MPEP states, in part, the following:

“An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.”

* * *

“It should be noted that under 37 CFR 1.181(f), the filing of a 37 CFR 1.181 petition will not stay the period for reply to an examiner’s action which may be running against an application. See MPEP § 1207 for appeal and post-appeal procedure.”

The Amendment and Response after Final Rejection received on May 19, 2003 was been duly considered by the examiner and did not place the application in condition for allowance for the reasons stated in the Advisory action.

Under current practice, since the Amendment and Response after Final Rejection did not placed the application in condition for allowance, a proper reply to the Final Rejection was not timely filed and accordingly the application became abandoned by operation of law for failure to timely file a reply to the Final Rejection of February 27, 2003.

A Notice of Appeal (and fee) or a request for continued examination (RCE) and fee or another amendment which placed the application in condition for allowance would have been a proper reply to Final Rejection if timely filed. A review of the application file does reveal that any such papers were filed.

In view of the above stated reasons, the application remains abandoned and the petition to withdraw the holding of abandonment for the above-identified application is denied.

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision.

The request for Continued Examination is noted. Petitioner may wish to consider filing a petition under 37 CFR 1.137(a) or (b) requesting that the application be revived where the request for Continued Examination may be properly considered.

Inquiries regarding this decision should be directed to Jose' G. Dees at (703) 308-4628.



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